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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,351	09/30/2003	William T. Ball	P06545US0-144	5782
34082	7590	07/25/2005	EXAMINER	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			PATEL, VISHAL A	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,351

Applicant(s)

BALL, WILLIAM T.

Examiner

Vishal Patel

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/5/05 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, line 1, "a pipe coupling", how can a pipe coupling having a pressurized fluid supply pipe having an end secured within one of the wells.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Oliver (US. 4,266,813).

The Oliver device illustrates applicant's invention in fig. 6 with a pipe coupling or joining a first pipe to pipes of varying diameters including a first metal (as shown by the cross-hatchings) hollow fitting having opposite first and second ends (see fig. 6), with the first end being adapted for connection to a first pipe 22 and having a sleeve with a typically inwardly crimped detent (detents between two adjacent threads (18), a second and plastic hollow fitting 10 having first and second ends with the second end 18 being joined inside the second end of the first hollow fitting in sealed condition to define a fluid conduit extending through interiors of the first and second hollow fittings. The second end having a groove for receiving the detent (the detent received in the groove formed by two adjacent threads). As best shown in figure 3, the second fitting includes first 28 and second 26 adjacent wells in the second hollow fitting 10, with the first well being adjacent the second end of the second fitting and having an upper end terminating in the first well at a shoulder portion. The first and second wells being cylindrical in shape with the second wall having a diameter greater than the diameter of the first well, whereupon inlet pipes 30,32 (figs 5 and 6) having outside diameters complimentary in size to the diameters of the wells can be selectively and alternately secured within the respective wells to fluidly connect such pipes to the fluid conduit and the first hollow fitting. A pressurized fluid supply pipe having an end secured within one of the wells (the pipe end of 30 that is secured in the wells).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (3,612,584) in view of Weir III (US. 4,712,812).

The Taylor device illustrates applicants' invention in figure 2 with a metal to plastic transition coupling for joining a first pipe other pipes, including a first metal 20 hollow fitting having opposite first and second ends, with the first end being adapted for connection to a first pipe 12 and having a sleeve with a typically inwardly crimped detent (the internal threads, which are the detents are on the sleeve 19 and are crimped into recesses formed in a second end of the second hollow fitting 32), a second and plastic hollow fitting 32 having first and second ends with the second end 30 being joined inside the second end 19 of the first hollow fitting in sealed condition to define a fluid conduit extending through interiors of the first and second hollow fittings. The second fitting includes well 36 at its first end for accepting pipe 14. A pressurized fluid supply pipe having an end secured within one of the wells (pipe 14) and an adhesively secured with the well (column 2, line 48). However the Taylor coupling does not disclose multiple wells in the first end of the second fitting for accepting pipes of differing diameters. Weir, III discloses in figure 7 for example that it is known in the art to provide a similar type coupling 43 with one end 50 for insertion into a member and another end 44 having multiple wells 48,46 with walls 49,47 for accepting pipes of differing diameters such as is illustrated in figures 2 and 3 wherein pipes 118 and 121 of differing diameters are shown in the stepped wells. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the first end 34 of the second fitting 32 of

Taylor with multiple wells for pipes of differing diameters as taught by Weir, III (figs. 2,3,7) in place of the single well 36 in order for the coupling to be more versatile by accepting more than just one size pipe.

Response to Arguments

8. Applicant's arguments filed 5/5/05 have been fully considered but they are not persuasive.

Applicants' argument that neither Oliver or Taylor teach a typically inwardly crimped detent is not persuasive because as stated above that Oliver illustrates the detent of the thread that is received in a groove of another thread and similarly Taylor illustrates that the detent of the thread of 19 is received in a groove 30 of another thread.

Applicants' argument that Oliver does not illustrate or teach the second end fitting slidably within the second end of the first hollow fitting in sealed condition is not persuasive because the Oliver device illustrates the claim, which now recites that second end of the second fitting is slidably within the second end of the first hollow fitting in sealed condition (the sealed condition is provided because of the meshing of the threads on the first hollow fitting and the second hollow fitting).

Again the examiner disagrees, as shown in fig. 6 of Oliver, the second end of the second fitting 18 is threaded within the second end of the first hollow fitting. It is the examiners position that threading an element into another element reads on the claim limitation of "sliding" since plainly the flanks of the male threads slide past the flanks of the threads of the female threads as the second member is slid in the axial direction to fit into the first member. Applicant further argues that the Oliver device does not teach a smooth continuous surface and instead teaches male threads 18 for the hose fitting 20.

Here applicant's arguments appear more limiting than the claims themselves since the claims do not recite "a smooth continuous surface" as argued.

As to the rejection of claim 1-6 under 35 U.S.C. section 103 applicant presents on pages 7-9 various case law citations which discuss the proper usage of 35 U.S.C. section 103 to which the examiner agrees with the citations and believes to be in compliance with the law. Applicant argues on pages 7-8 that the examiner has used impermissible hindsight and lack of motivation to combine.

"Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the identification of the relevant art, the level ordinary skill in the art, the nature of the problem to be solved, or any other facts or findings that might serve to support a proper obviousness analysis."

The examiner disagrees, as was pointed out in the rejection such motivation can be found in "order for the coupling to be more versatile by accepting more than just one size pipe". While applicant argues that no information in Taylor suggests such a combination the examiner points out first, that if it did the rejection would be made under anticipation and not obviousness and second, as applicant has already made clear in the remarks on page 7-8.

Suggestion need not come from the prior art references themselves but may come from the nature of the problem solved. It is the position of the examiner that where a person having an ordinary skill in the art is faced with the problem of not having a fitting of the proper size for various size pipe one would look to such a teaching as Weir, III wherein it is known to provide stepped internal diameters of increasing size in order to reduce the need for multiple conventional fittings. See column 1, lines 10-25.

A person of ordinary skill in the art would readily recognize such a feature as an obvious expedient and therefor such a modification does not patentably define over the prior art. Further, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Also the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant further argues that even if the prior art was combinable it would not read on the claims as now amended. As discussed above the examiner disagrees, as clearly shown in fig. 2 the thread 30 of the second hollow fitting 32 provides a helical groove at its second end. The helical groove of the male thread 30 receives the helical detent of the of the female thread of the first hollow fitting 20. Applicant further argues that claim 5 as now amended defines over the prior art combination since the claim now recites that second end of the second fitting is slidably within the second end of the first hollow fitting. Again the examiner disagrees, as clearly shown in fig. 2 the second end 30 of the second fitting 32 is threaded within the second end of the first hollow fitting 20. It

is the examiners position that threading an element into another element reads on the claim limitation of "sliding" since plainly the flanks of the male threads slide past the flanks of the threads of the female threads as the second member is slid in the axial direction to fit into the first member. As to the amendment to claim 7 see column 2, lines 45-50 which clearly discloses that a pipe 14 is secured via a suitable adhesive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP
July 15, 2005

A handwritten signature in black ink, appearing to read "Vishal Patel", with a stylized flourish at the end.

Vishal Patel
Patent Examiner
Tech. Center 3600